

09/882,857

MS150900.15/MSFTP248US

**REMARKS**

Claims 1, 2, 6, 8-28, 30-37 and 39-47 are currently pending in the subject application and are presently under consideration. Claims 1, 34, 44, 46 and 47 have been amended. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

**I. Rejection of Claims 1, 2, 6, 34, 37, 43, 44 and 47 Under 35 U.S.C. §103(a)**

Claims 1, 2, 6, 34, 37, 43, 44 and 47 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Giles, *et al.* (USPN: 6,437,812) hereinafter Giles in view of Wichelman, *et al.* (USPN: 6,590,587) hereinafter Wichelman. Withdrawal of this rejection is respectfully requested for at least the following reason. Neither Giles nor Wichelman, alone or in combination, teach or suggest all of the claim limitations. In addition, there is no teaching, suggestion, or motivation to combine the teachings of Giles and Wichelman and the Examiner has not provided any *evidence in the prior art or other reference of record* to show otherwise. Thus, the Examiner has not established a *prima facie* case of obviousness and the cited references do not render obvious the subject matter as a whole.

The test of obviousness is whether "the subject matter sought to be patented and the prior art are such that the subject matter as a *whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art." (*Graham v. John Deere Co.*, 383 U.S. 1, 3 (1966) (emphasis added); *see also e.g., In re Dembiczak*, 175 F.3d 994, 998, 50 U.S.P.Q. 1614, 1616 (Fed. Cir. 1999)). In evaluating obviousness, the PTO must conduct the factual inquiry as outlined in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). (*See In re Lee*, 277 F.3d 1338, 1342-43, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002)). The factual inquiry to be conducted includes determining: (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. (*See Graham*, 383 U.S. 1, 17-18 (1966)). The PTO must "not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." (*In re Lee*, 277 F.3d at 1344, 61 U.S.P.Q.2d at 1434). The PTO cannot rely merely on conclusory statements and assertions of "common sense" to remedy deficiencies of the cited references. (*In re Lee*, 277 F.3d at 1344, 61 U.S.P.Q.2d at 1434). If the PTO relies on multiple prior art

09/882,857

MS150900.15/MSFTP248US

references as the basis for an obviousness rejection, it is not enough that all of the claim limitations appear in the prior art. To establish a *prima facie* case of obviousness, the PTO must also make an adequate showing of a suggestion, teaching, or motivation to combine the prior art references. (See *In re Dembiczak*, 175 F.3d 994, 999-1001, 50 U.S.P.Q. 1614, 1617 (Fed. Cir. 1999) (citing to *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998)); see also *In re Lee*, 277 F.3d at 1343, 61 U.S.P.Q.2d at 1433). Only if the PTO establishes a *prima facie* case of obviousness does the burden of coming forward with evidence or argument shift to the applicant. (See *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992)).

The independent claims 1, 34 and 44 recite the limitations the notification system *senses implicit user actions and adjusts the prioritization of one or more notifications based on the implicit user actions and according to the user's context* or similar limitations. The Examiner contends that Wichelman discloses sensing implicit user actions because:

as noted in the Applicant's specification page 11, lines 22-24: Implicit feedback can include such actions as how fast a user responds to or reads a selected notification, including delays interacting with a notification and whether or not a notification is deleted or saved as the technique of the GUI software 32 enables the user to specify performance of the burst counter test 64f and the determination is made by the GUI software 32 as to whether the burst counter test 64f is enabled by the user. If so, when the GUI software 32 enables the user to enable or disable alarms and set alarm limits relative to the burst counter test 64f as denoted at block 144. If not, the process flow reverts to block 145, where the GUI software 32 enables the user to save or cancel the aforementioned data (see col. 26, lines 16-24).

(Office Action May 20, 2005 at pp. 3-4). Applicants' representative respectfully disagrees. The section of Wichelman cited to by the Examiner describes a user's explicit interaction with a computer. In the system of Wichelman, the user must explicitly specify whether to enable or disable the alarm. As described in the subject application and consistent with the plain meaning of the word "implicit," implicit user actions are those that are implied by the user's explicit actions. In other words, the system infers whether and how to adjust the prioritization of the notifications rather than having the user explicitly specify how to adjust the prioritization of the

09/882,857

MS150900.15/MSFTP248US

notifications. Additionally, in order to expedite allowance of the subject claims, the claims have been amended to recite the limitation that the prioritization is *adjusted according to the user's context*. Neither Giles nor Wichelman, alone or in combination, teach or suggest context-aware interfaces.

Moreover, the Examiner contends that it would be obvious to combine the teachings of Giles with the teachings of Wichelman because “[b]y doing so, the system would be enhanced by capable of providing implicit user actions to its end user wherein end user quickly and easily interacting upon the condition of fraud alert.” (See Office Action at pp. 4 and 23). However, the Examiner does not cite to *any evidence in the prior art or other reference of record* that would motivate, teach or suggest *combining* the teachings of Giles with those of Wichelman. Instead, the Examiner is basing the rejection on the assertion that it would have been obvious to do something not suggested in the art but, rather, suggested by the advantages disclosed in applicants’ specification. This sort of approach has been repeatedly condemned by the Federal Circuit as entering the “tempting but forbidden zone of hindsight.” (*In re Dembiczak*, 175 F.3d at 998, 50 U.S.P.Q. at 1616 (citing to *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 873, 228 U.S.P.Q. 90, 98 (Fed. Cir. 1985), overruled on other grounds by *Nobelpharma AB v. Implant Innovations, Inc.*, 141 F.3d 1059, 46 U.S.P.Q.2d 1097 (Fed. Cir. 1998))). The Federal Circuit has warned against imbuing “one of ordinary skill in the art with knowledge of the invention in suit when *no prior art reference or references of record* convey or suggest knowledge,” and falling “victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” (*In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (citing to *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)) (emphasis added); see also *In re Dembiczak*, 175 F.3d at 998-99, 50 U.S.P.Q. at 1616-17). As the Federal Circuit has stated:

Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. Combining prior art

09/882,857

MS150900.15/MSFTP248US

references *without evidence* of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight. . . . [T]he showing must be *clear and particular*. *Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence."*

(*In re Dembiczak*, 175 F.3d at 999, 50 U.S.P.Q. at 1617) (internal citations omitted) (emphasis added). The Examiner has not cited to any *prior art references or other references of record* that teach or suggest *this purported motivation to combine*. Indeed, all the Examiner has done is provided the "[b]road conclusory statements" that the Federal Circuit has held are not evidence that can support an obviousness rejection. (*In re Dembiczak*, 175 F.3d at 999, 50 U.S.P.Q. at 1617). In view of at least the foregoing, the subject claims are in condition for allowance and applicants' representative respectfully requests that this rejection be withdrawn.

**II. Rejection of Claims 8-14, 16-18, 20-25, 28, 30-32, 35, 36, 39-42, 45 and 46 Under 35 U.S.C. §103(a)**

Claims 8-14, 16-18, 20-25, 28, 30-32, 35, 36, 39-42, 45 and 46 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Giles in view of Wichelman and further in view of Tanaka, *et al.* (USPN: 5,471,399) hereinafter Tanaka. Withdrawal of this rejection is respectfully requested for at least the following reason. All of the claims recite the limitations the notification system *senses implicit user actions and adjusts the prioritization of one or more notifications based on the implicit user actions and according to the user's context* or similar limitations. As explained *supra*, neither Giles nor Wichelman, alone or in combination, teach or suggest all of the claim limitations and Tanaka does not remedy the aforementioned deficiencies. In addition, there is no teaching, suggestion, or motivation to combine the teachings of Giles and Wichelman and the Examiner has not provided any *evidence in the prior art or other reference of record* to show otherwise. Thus, the Examiner has not established a *prima facie* case of obviousness and the cited references do not render obvious the subject matter as a whole. In view of at least the foregoing, the subject claims are in condition for allowance and applicants' representative respectfully requests that this rejection be withdrawn.

09/882,857

MS150900.15/MSFTP248US

**III. Rejection of Claims 15 and 41 Under 35 U.S.C. §103(a)**

Claims 15 and 41 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Giles in view of Wichelman and Tanaka and further in view of Battat, *et al.* (USPN: 6,289,380) hereinafter Battat. Withdrawal of this rejection is respectfully requested for at least the following reason. All of the claims recite the limitations the notification system *senses implicit user actions and adjusts the prioritization of one or more notifications based on the implicit user actions and according to the user's context* or similar limitations. As explained *supra*, neither Giles nor Wichelman nor Tanaka, alone or in combination, teach or suggest all of the claim limitations and Battat does not remedy the aforementioned deficiencies. In addition, there is no teaching, suggestion, or motivation to combine the teachings of Giles and Wichelman and the Examiner has not provided any *evidence in the prior art or other reference of record* to show otherwise. Thus, the Examiner has not established a *prima facie* case of obviousness and the cited references do not render obvious the subject matter as a whole. In view of at least the foregoing, the subject claims are in condition for allowance and applicants' representative respectfully requests that this rejection be withdrawn.

**IV. Rejection of Claims 19, 26, 27 and 33 Under 35 U.S.C. §103(a)**

Claims 19, 26, 27 and 33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Giles in view of Wichelman and Tanaka and further in view of Simonoff, *et al.* (USPN: 6,078,322) hereinafter Simonoff. Withdrawal of this rejection is respectfully requested for at least the following reason. All of the claims recite the limitations the notification system *senses implicit user actions and adjusts the prioritization of one or more notifications based on the implicit user actions and according to the user's context* or similar limitations. As explained *supra*, neither Giles nor Wichelman nor Tanaka, alone or in combination, teach or suggest all of the claim limitations and Simonoff does not remedy the aforementioned deficiencies. In addition, there is no teaching, suggestion, or motivation to combine the teachings of Giles and Wichelman and the Examiner has not provided any *evidence in the prior art or other reference of record* to show otherwise. Thus, the Examiner has not established a *prima facie* case of obviousness and the cited references do not render obvious the subject matter as a whole. In view of at least the foregoing, the subject claims are in condition for allowance and applicants' representative respectfully requests that this rejection be withdrawn.

09/882,857

MS150900.15/MSFTP248US

CONCLUSION

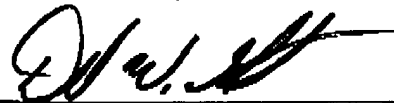
The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP248US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

AMIN & TUROCY, LLP



David W. Grillo  
Reg. No. 52,970

AMIN & TUROCY, LLP  
24<sup>TH</sup> Floor, National City Center  
1900 E. 9<sup>TH</sup> Street  
Cleveland, Ohio 44114  
Telephone (216) 696-8730  
Facsimile (216) 696-8731